

### **REMARKS**

Claim 3 has been amended herein. Claims 16-19 have been added. Claims 1-19 are now pending in the Application.

#### **Applicants Request Acknowledgment Of Their Right to Priority**

The Application has been amended herein to provide a cross reference to the related applications. Such a reference to these related applications and Applicants' claim to the benefit thereof was indicated in an Amendment included in the Transmittal filed with the Application on November 17, 1998. This Amendment is found at pages 1 of 2 of the Added Pages for Application Transmittal Where Benefit of Prior U.S. Application(s) Claimed. Applicants are presenting this Amendment to assure that their claim for priority is recognized.

The Examiner is also thanked for the courtesy of the interview on March 26, 2001. During the interview, the undersigned pointed out to the Examiner that the present Application claims priority of several prior Applications and that features recited in the independent claims are disclosed and are entitled to the benefit of Provisional Application 60/031, 956 filed November 27, 1996.

Acknowledgment of Applicants' claim of priority is appreciated.

#### **Errors in the Specification Have Been Corrected**

Applicants have amended the Specification to correct errors in reference numerals that occurred on page 23, line 13 and page 23, line 15. In both cases reference number [34] was

changed to --38--. Likewise an error was noted on page 70, line 11 wherein the reference to Figure 29 was corrected to indicate that the proper figure is Figure 27.

No new matter will be added as a result of the correction of these typographical errors through amendment of the Specification.

#### **Corrections to the Drawings Are Being Submitted**

A Request to Amend Drawings is also being submitted herewith. The Request to Amend Drawings corrects two errors in reference numerals which were noted in the Application. The Request to Amend Drawings also includes labels for the unlabeled elements previously presented so as to enhance clarity. No new matter will be added as a result of these changes and correction of the drawings by substitution is requested.

Applicants are also submitting herewith formal corrected drawings to substitute for the informal drawings currently pending.

#### **The Title Has Been Amended**

In the Action, the title was objected to as not descriptive. Applicants respectfully traverse this objection. However, a new title has been provided to indicate that the claims of the pending Application are specifically directed to features associated with apparatus and methods for indicating the status of devices in an automated banking machine.

### **Claim 3 Is Not Indefinite**

In the Action, claim 3 was objected to pursuant to 35 U.S.C. § 112, 2nd Paragraph, for allegedly being indefinite. Applicants respectfully traverse this objection.

Claim 3 recites that the status is representative of a fault which has occurred in a transaction function device. Applicants respectfully submit that this is clear from the original wording of claim 3. However, Applicants have added this additional language to the claim so as to eliminate any possibility of ambiguity as to the meaning of the claim.

### **Applicants' Claims Are Not Anticipated by the Bank Network News Article**

In the Action, claims 1-5, 7-8 and 11-13 were rejected pursuant to 35 U.S.C. § 102(a) as anticipated by an article in Bank Network News dated April 11, 1997 (hereinafter "BankNet Article"). This rejection is respectfully traversed.

First, Applicants wish to point out that the present Application is entitled to the benefit of Provisional Application Serial No. 60/031,956 filed November 27, 1996. This Application discloses in detail all of the features and relationships which are alleged to be "inherent" in the BankNet Article. Specifically the priority application discloses an automated banking machine with at least one transaction function device, a server in operative connection with the transaction function device and at least one HTML document accessible through the server. This Application further discloses an HTML document including instructions or indicia which correspond to a condition or status of a transaction function device. As all of these features are clearly disclosed in the priority Application, the BankNet Article does not constitute prior art.

The rejection is therefore improper and Applicants respectfully submit that the rejection should be withdrawn.

### **The BankNet Article Does Not Disclose the Claimed Features**

Applicants respectfully wish to point out that even though the BankNet Article does not constitute prior art against Applicants' invention, it also does not disclose or suggest the features recited in Applicants' claims.

### **The Applicable Legal Standard**

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1541, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention presented in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 U.S.P.Q. 2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure "could" or "might" be

used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

### **The BankNet Article Does Not Disclose All The Recited Features**

The Patent Office bears the burden of showing that all the features and relationships in Applicants' claims are shown in the single prior art reference. The BankNet Article is not prior art. The BankNet Article also does not disclose the recited features and relationships.

The total allegedly pertinent disclosure in the BankNet Article is found in the second paragraph on page 1 and the first paragraph on page 2. The second paragraph on page 2 states only that Canadian Imperial Bank of Commerce will test a "concept" using "Internet-type technology." The first paragraph on the second page indicates that theoretically an individual who ordered opera tickets through a bank's web site might get a message asking if they want tickets printed out at an ATM. It is further stated that a user can get information at an ATM like they get information on their PC. There is absolutely no disclosure in the BankNet Article, however, as to the apparatus, methods, systems or devices to be used in accomplishing this result. Indeed the article itself expressly indicates that what was described was purely a "concept." There is no indication in the BankNet Article that the parties whose activities were being reported on knew how to achieve such a system. Clearly there is no teaching or disclosure in the BankNet Article to one skilled in the art as to what the parties discussed in the article were planning to do in terms of an actual system or how they would go about making or operating such a system.

Specifically there is no disclosure in the BankNet Article of the features specifically recited in the claims. For example, there is no disclosure of a server in operative connection with a transaction function device, an HTML document accessible through the server, or an HTML document including indicia corresponding to a status of a particular transaction function device as recited in claim 1. Likewise the BankNet Article makes no mention of the features recited in claim 7 such as an automated transaction machine which generates an HTML document that includes instructions corresponding to the status of one of the transaction function devices in the machine. There is clearly no showing in the BankNet Article of an automated transaction machine which includes software which causes a computer in the machine to generate HTTP records with indicia representative of the status of at least one transaction function device operating in the machine as recited in claim 12. As the BankNet Article does not disclose the features and relationships recited in Applicants' main claims, the BankNet Article plainly cannot anticipate such claims.

Further, before any rejection may be based on inherency, the Patent Office bears the burden of showing actual prior art which establishes that the alleged teaching which is missing from the reference is necessarily present in what is shown in the reference. The Patent Office has shown no such prior art as is necessary to prove inherency. For this reason, it is respectfully submitted that the rejection is not legally supportable.

It is respectfully submitted that all of Applicants' pending claims should be allowed because the BankNet Article which is the primary reference cited by the Patent Office does not constitute prior art. All of the pending claims should further be allowed because the BankNet Article does not show all of the features and relationships recited in Applicants' claims either

literally or inherently. It is therefore respectfully submitted that claims 1, 7 and 12 and all the claims that depend therefrom should be allowed.

**Applicants' Dependent Claims Also Recite Features and Relationships Not Disclosed in the BankNet Article**

The BankNet Article does not constitute prior art. The BankNet Article also does not disclose or suggest the features and relationships recited in Applicants' independent claims. Applicants also respectfully wish to point out that the BankNet Article also does not disclose or suggest features recited in Applicants' dependent claims. For example, the BankNet Article does not disclose or suggest the following:

a transaction device that is operative in response to an HTTP message received by the server (Claim 2);

indicia in an HTML document accessible through a server which is representative of a status which represents a fault which has occurred in a transaction function device (Claim 3);

an HTML document accessible through a server which includes indicia corresponding to a status of each of a plurality of transaction function devices (Claim 4);

an ATM device which has the features recited in claim 1 (Claim 5);

a method in which an HTML document which includes instructions corresponding to the status of a transaction function device, is accessed with a terminal including a browser (Claim 8);

receiving an HTML document with a machine which includes second instructions, and operating the transaction function device in response to the second instructions included in the second HTML document (Claim 11);

an automated transaction machine which generates HTTP records in the form of at least one HTML document which includes indicia representative of the status of at least one transaction function device, and which HTML document is accessible in the machine through a server (Claim 18).

These are but a few examples of features not found in the BankNet Article and Applicants reserve the right to cite many more. The Action admits that the BankNet Article does not disclose these features. The Action provides no proof by way of citation to prior art that the claimed features are necessarily present in the system mentioned in the BankNet Article. Indeed, the BankNet Article makes clear that the system described therein was a "concept" that did not even exist, and therefore such undisclosed features cannot be "necessarily present" as is required to sustain an inherency rejection.



For these reasons it is respectfully submitted that claims 1-5, 7-8 and 11-13 are allowable.

**Applicants' Claims Are Not Obvious**

In the Action, claims 6, 9 and 14-15 were rejected pursuant to 35 U.S.C. § 103(a) as obvious over the BankNet Article. This rejection is respectfully traversed.

**The BankNet Article is Not Prior Art**

As previously discussed, the BankNet Article is substantially after Applicants' priority date. For this reason the BankNet Article does not constitute prior art against Applicants.

**The Applicable Legal Standard**

Although the BankNet Article does not constitute prior art against Applicants, it is also respectfully asserted that the BankNet Article does not render the pending claims obvious.

Before a claim may be rejected on the basis of obviousness, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as prima facie obviousness. To establish prima facie obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. MPEP § 2142.

Further, even if all the features and relationships recited in the claim are shown in the prior art, an obviousness rejection is still not proper unless there is also shown in the prior art a teaching, suggestion or motivation to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.* 810 F2d. 1561, 1568, 1 U.S.P.Q. 2d 1593 (Fed. Cir. 1987).

A teaching, suggestion or motivation to combine features in prior art references must be clearly and particularly identified in the prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a range of sources and make conclusory statements. *In re Dembiczak*, 15 U.S.P.Q. 2d 1614, 1617 (Fed. Cir. 1999).

It is respectfully submitted that the Action has not shown that the inventions as claimed by Applicants are obvious over the BankNet Article.

#### **Claim 6**

Claim 6 depends from claim 1 and is allowable for the same reason. Claim 6 further recites a portable terminal including a browser. Claim 6 further recites that the terminal including the browser is operative to access the HTML documents which includes indicia corresponding to status of a transaction function device. Nothing in any prior art discloses or suggests this, or provides any motivation for producing the combination of features recited in Applicants' claim.

The Action alleges "official notice" that portable terminals are well known, and for this reason it would be obvious to produce the invention recited in claim 6. Applicants respectfully traverse the alleged official notice. MPEP § 2144.03. Applicants also respectfully wish to point out that there is absolutely no teaching, suggestion or motivation in any cited reference for using a portable terminal including a browser to access an HTML document including indicia corresponding to the status of a transaction function device in an ATM. For these reasons it is respectfully submitted that claim 6 is further allowable.

### **Claim 9**

Claim 9 depends from claim 8 and further recites that in the method of claim 8, the accessing step includes accessing the first document with a portable terminal adjacent to the automated transaction machine. By reference to claim 8 and claim 7 from which claim 9 depends, the first document that is accessed includes at least one HTML document that includes instructions corresponding to the status of a transaction function device. Nothing in the cited references discloses or suggests producing such documents in an automated transaction machine, nor accessing such a document with a portable terminal adjacent to the automated transaction machine.

Again the Action allegedly takes official notice and Applicants traverse the official notice and require the Office to prove the existence of the recited features in the prior art. Further, the official notice refers to accessing through the Internet using a portable computer. However, the claim does not specifically or only recite such features.

No citation to any prior art teaching, suggestion or motivation so as to produce the claimed invention is found in the Action.

As claim 9 recites features and relationships that are not disclosed or suggested in the cited art, it is respectfully submitted to be further allowable.

### **Claim 14**

Claim 14 depends from claim 12 and further recites that the HTTP record which includes indicia representative of the status of transaction function devices, comprises a data object. The Action then asserts without reference to any prior art whatsoever, that it would be obvious to

have the HTTP record comprise a data object. This rejection is legally deficient as the Office has neither shown that the features recited in the claim are known in the prior art nor has there been any citation to any prior art showing teaching, suggestion or motivation so as to produce the claimed invention.

#### **Claim 15**

Claim 15 depends from claim 14 and further recites a terminal computer outside the automated transaction machine, and a communications connection operatively connecting the computer outside the machine with a computer within the machine. Claim 15 further recites terminal software operative to transfer the data object from the automated transaction machine to the terminal computer.

The Action admits that these features are not disclosed or suggested in the BankNet Article. However, the Action alleges without any support or citation to prior art, that such features are inherently disclosed. As previously discussed, such an allegation of inherency is improper absent a showing based upon prior art that the reference necessarily includes such features. Further, the Action alleges that object oriented programming is old and well known. There is no support for this contention, nor is there any citation to any prior art of the features claimed by Applicants nor any teaching, suggestion or motivation in the prior art so as to produce Applicants' claimed invention.

Because the BankNet Article does not constitute prior art against Applicants' invention, it is respectfully submitted that the rejections posed against claims 6, 9 and 14-15 should be withdrawn. Further, the rejections presented against claims 6, 9 and 14-15 are improper as the

Office has failed to establish that the features recited in the claims are known in the prior art, and has failed to show any prior art teaching, suggestion or motivation so as to produce the claimed combination.

**Applicants' Claims Are Not Obvious Over  
the Combination of the BankNet Article and Zeanah**

In the Action claim 10 was rejected pursuant to 35 U.S.C. § 103(a) as unpatentable over the BankNet Article and further in view of Zeanah. This rejection is respectfully traversed.

Applicants wish to point out again that the BankNet Article does not constitute prior art against the claimed invention. Further, Applicants are also prepared to establish reduction to practice prior to the filing date of Zeanah. For these reasons it is respectfully submitted that the rejection should be withdrawn.

**Claim 10**

Claim 10 depends from claim 8 and further recites that in the recited method the accessing step includes accessing the first document, which is an HTML document which includes instructions corresponding to the status of a transaction function device, through a network with a terminal located remotely from the automated transaction machine. The Action asserts that Zeanah discloses providing financial services to a remote device through an Internet, and that it would be obvious to one of ordinary skill in the art at the time the invention was made to use Zeanah's remote accessing with Bank Net's teaching of a web ATM. This assertion is respectfully traversed.

Applicants again wish to point out that the claim specifically recites accessing an HTML document which includes instructions corresponding to the status of a transaction function device, such as a malfunction or other condition. Nothing in any of the cited references discloses or suggests doing this. In addition, no prior art has been cited as providing any teaching, suggestion or motivation so as to produce the claimed combination.

For these reasons it is respectfully submitted that claim 10 is further allowable.

### **New Claims**

Claims 16-19 have been added herein. Each of these claims patentably distinguishes over the prior art for reasons previously stated.

Claim 16 recites an apparatus including an automated transaction machine. The automated transaction machine includes a plurality of transaction function devices including at least one note dispensing device. The claimed apparatus further includes a computer in operative connection with a plurality of transaction function devices, that is operative to cause the dispensing of at least one note from the machine. Claim 16 further recites that the computer is operative responsive to the occurrence of a malfunction of one of the transaction function devices to include indicia in at least one HTTP record representative of the malfunction. Claim 16 further recites a communications connection to the computer in the machine, which enables the at least one HTTP record which includes the indicia representative of the malfunction to be accessed. Nothing in the prior art discloses or suggests these features and it is respectfully submitted that claim 16 is allowable.

Claim 17 depends from claim 16 and specifically recites that the automated transaction machine comprises an ATM.

Claim 18 is a method claim which recites a method of operation of the apparatus recited in claim 16. Claim 18 recites operating a plurality of transaction function devices in an automated transaction machine and that the operation of such devices includes dispensing at least one note. Claim 18 further recites including indicia in at least one HTTP record representative of a malfunction which has occurred in at least one of the transaction function devices during operation of the machine. Claim 18 further recites the step of accessing the HTTP record with an external computer through a communications connection to the machine.

Nothing in the cited art discloses or suggests these steps, features and relationships and it is respectfully submitted that claim 18 is also allowable.

Claim 19 is an apparatus claim. Claim 19 recites an automated transaction machine which includes a plurality of transaction function devices. Claim 19 further recites a server in the machine in operative connection with the transaction function devices. At least one HTTP record includes indicia representative of an operational status of at least one of a plurality of transaction function devices is also included in the machine. Claim 19 further recites that a communications connection is in operative connection with the server and is adapted to communicate the at least one HTTP record to a computer outside of the automated transaction machine.

Nothing in the cited art discloses or suggests these features and relationships. Indeed nothing in the cited art discloses or suggests an automated transaction machine which includes indicia representative of operational status in at least one HTTP record. None of the cited art

even discusses the handling or indication of messages indicative of faults or malfunctions in an automated transaction machine.

For all these reasons it is respectfully submitted that claims 16-19 are allowable.

#### **Fees For Additional Claims**

Please charge the fees for 3 additional independent claims in excess of 3 (\$240) and any other fee due to deposit account 09-0428.

#### **Conclusion**

Applicants respectfully submit that all of the pending claims patentably distinguish over the prior art. The pending application is entitled to a priority date that is well in advance of the primary BankNet Article reference. Further, all of the pending claims recite steps, features and relationships that are neither disclosed nor suggested in any of the cited art. Allowance of all the pending claims is therefore requested.

Further examination and reconsideration of the Application is requested in view of the foregoing comments and amendments. The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,



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## PAGES MARKED TO SHOW CHANGES

### **The Paragraphs Beginning on Page 23, Line 6 And Ending at Page 24, Line 2 Have Been Changed as Follows:**

Returning to the sample transaction, in response to receiving the enable card reader message from the device application portion 84, the device server 92 is operative to generate a message through the intranet 16 to the device interfacing software portion 64 of the ATM 12. This message which comprises an HTTP record including instructions for operating the card reader, is directed to the IP Port indicated 74 which is where the device interfacing software portion 64 communicates. In response to receiving this message, the software portion 64 is operative to send a message or messages on the control bus which enables the card reader mechanism 38 [34].

Continuing with the transaction as shown in Figure 6, the input of the card by a customer to the card reader 38 [34] is operative to cause the card data to be read and the device interfacing program portion 64 to send a message to the device server 92 indicating that card data has been read. This message is transmitted by the device server through the intranet 16 to the device application portion 84. The device application portion then sends a message to the device server requesting the card data. The device server 92 transmits a message with instructions to deliver the card data from the device interfacing software portion 64 which responds with a message sending the card data through the intranet to the device server. The device server, if there is no basis for stopping the transaction, transmits an HTTP record including card data back through the intranet 16 to the device application portion 84.

**Paragraph Beginning at Page 70, Line 10 and  
Ending at Page 70, Line 16 Has Been Amended as Follows:**

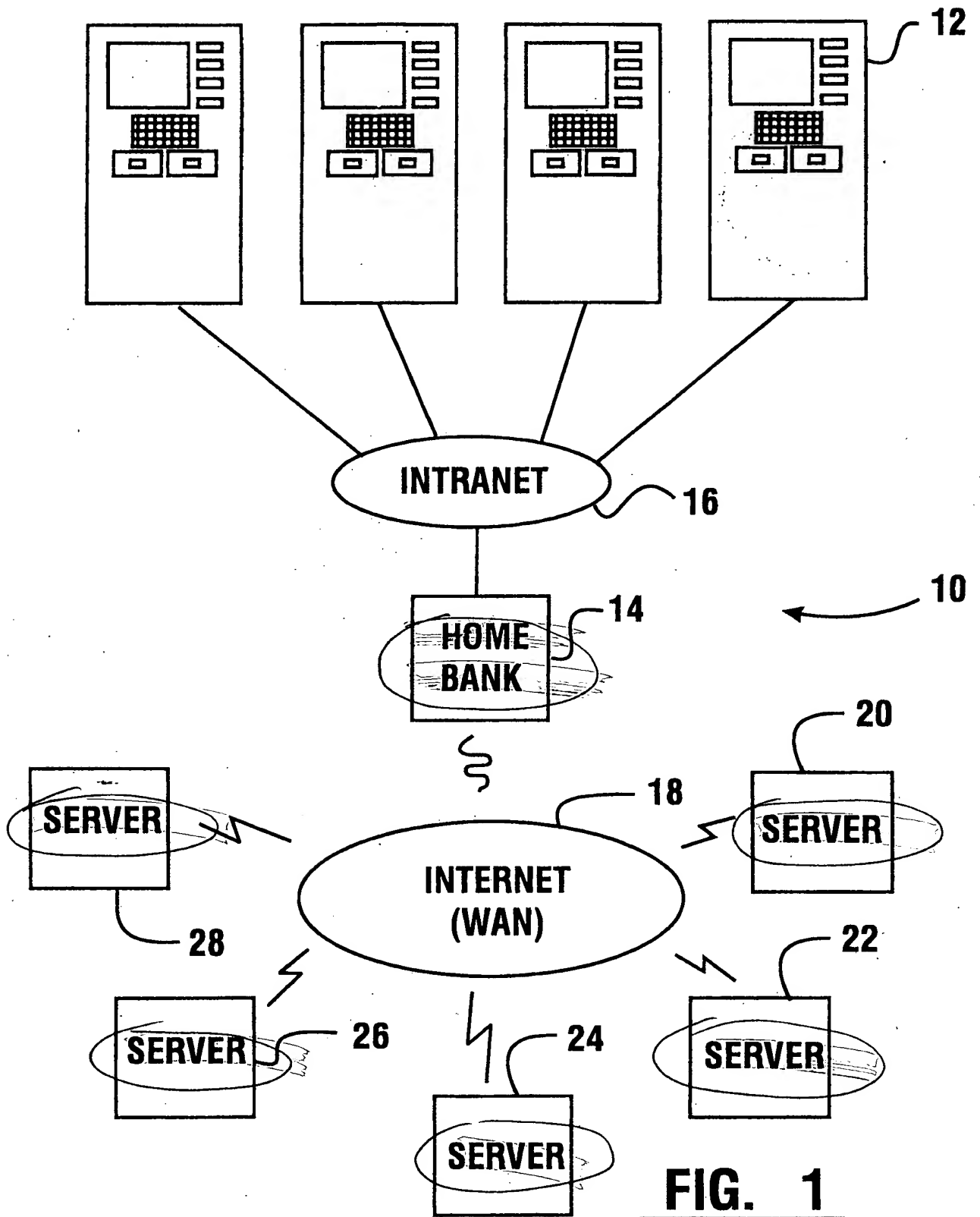
Figures 28-30 include schematic depictions of examples of the operation of the keyboard mapper and the keypad applet. Figure 27 [29] shows an example of an input to the keypad 168. In this example the keypad applet 170 generally in response to instructions in an HTTP record such as an HTML document or other events, transmits and enables events to the transaction services application 146. In response, a map set is selected from the database 176 corresponding to the particular map name. The keyboard command server is further operative to enable the appropriate keys of the ATM.

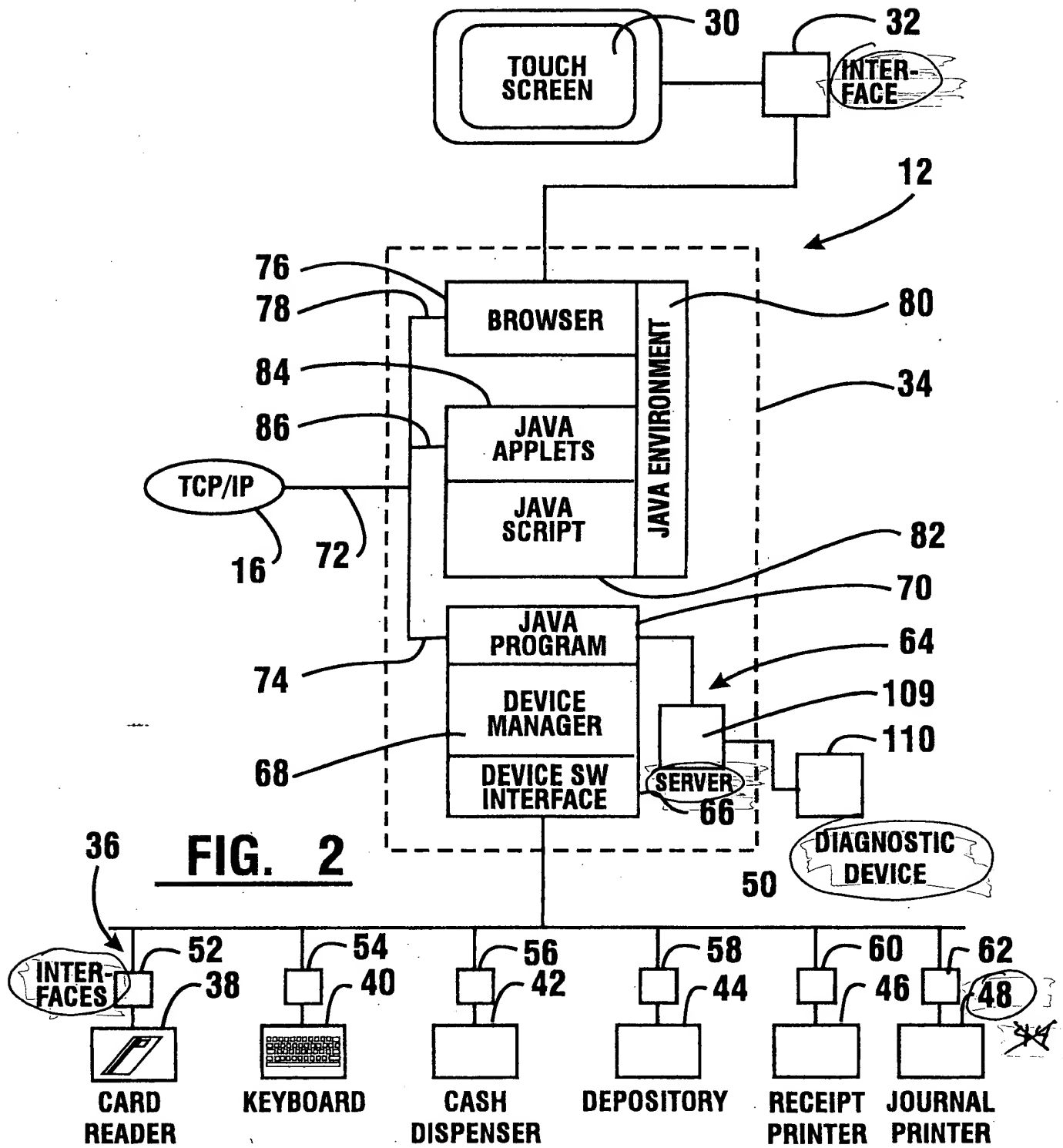
**In the Claims**

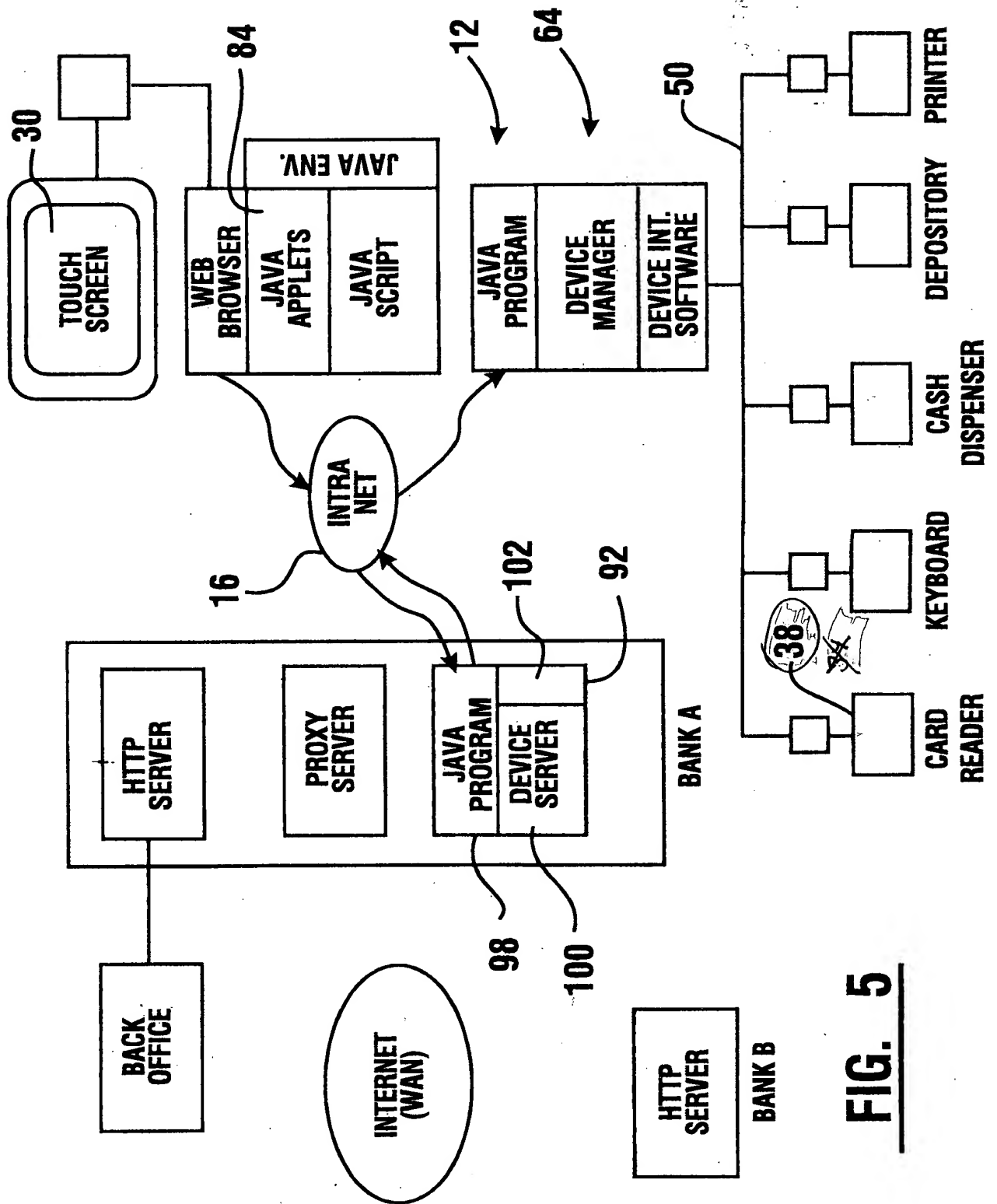
Claim 3 has been amended as follows:

3. (once amended) The apparatus according to claim 1 wherein the status is representative of a fault which has occurred in the transaction function device.

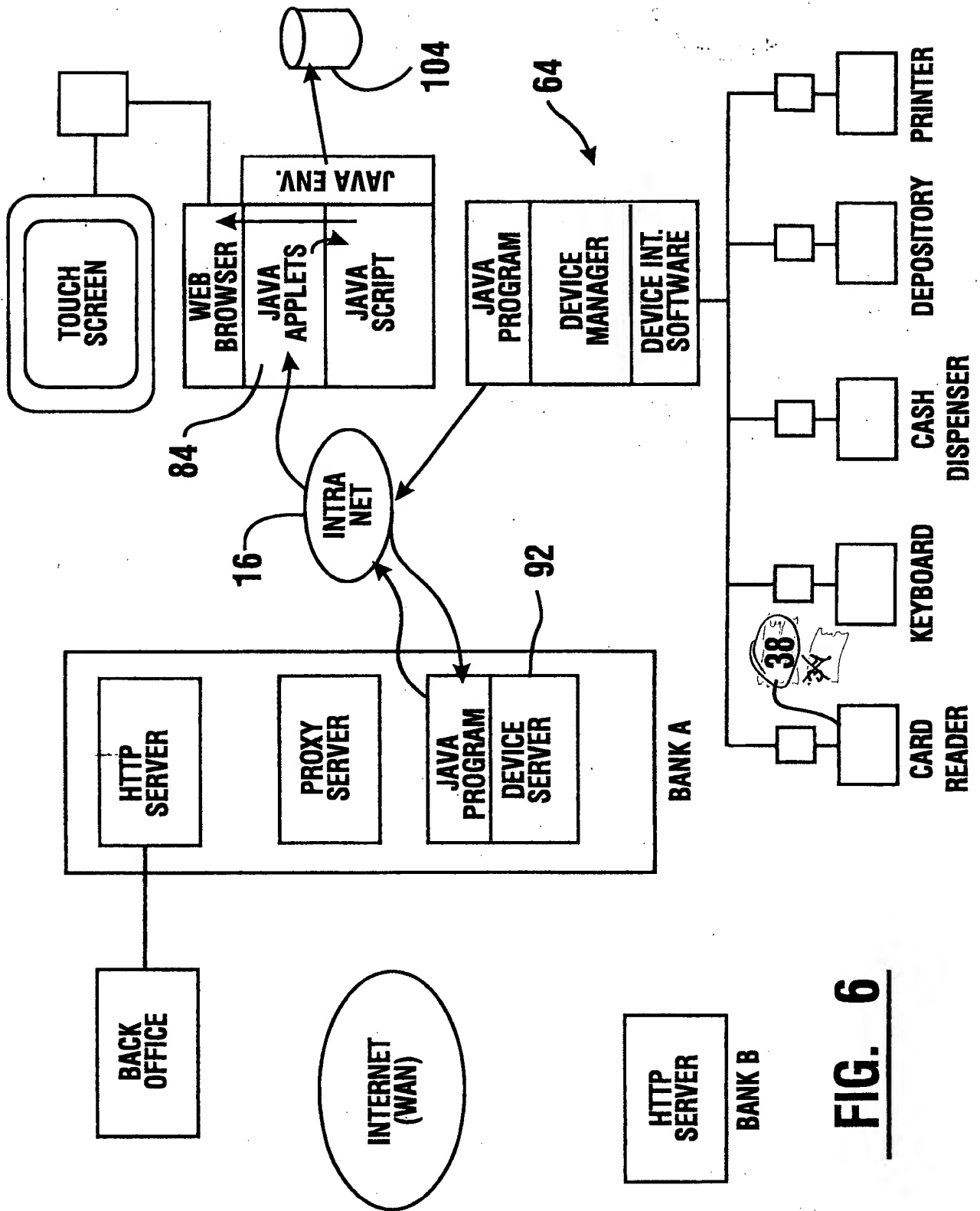
#8

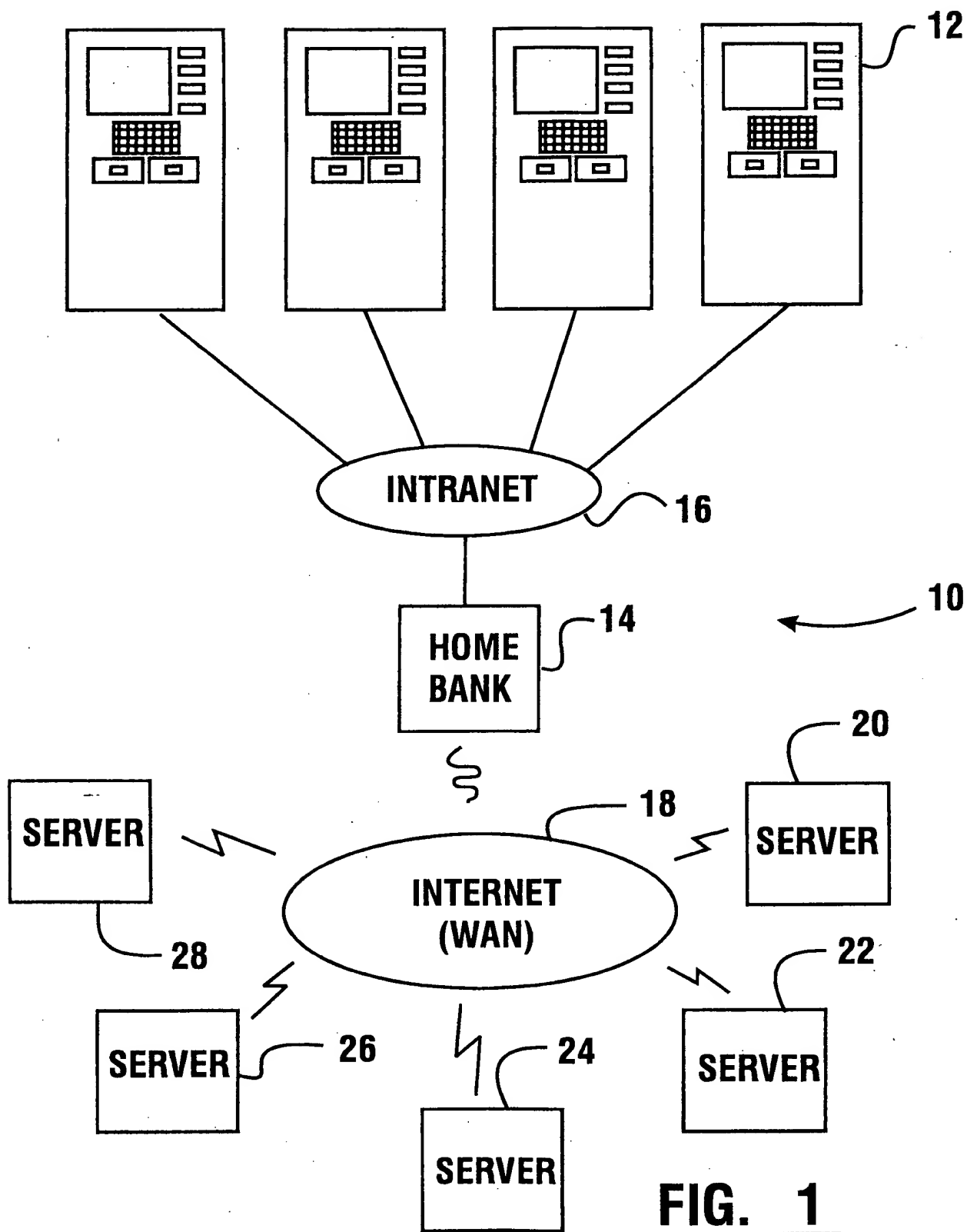


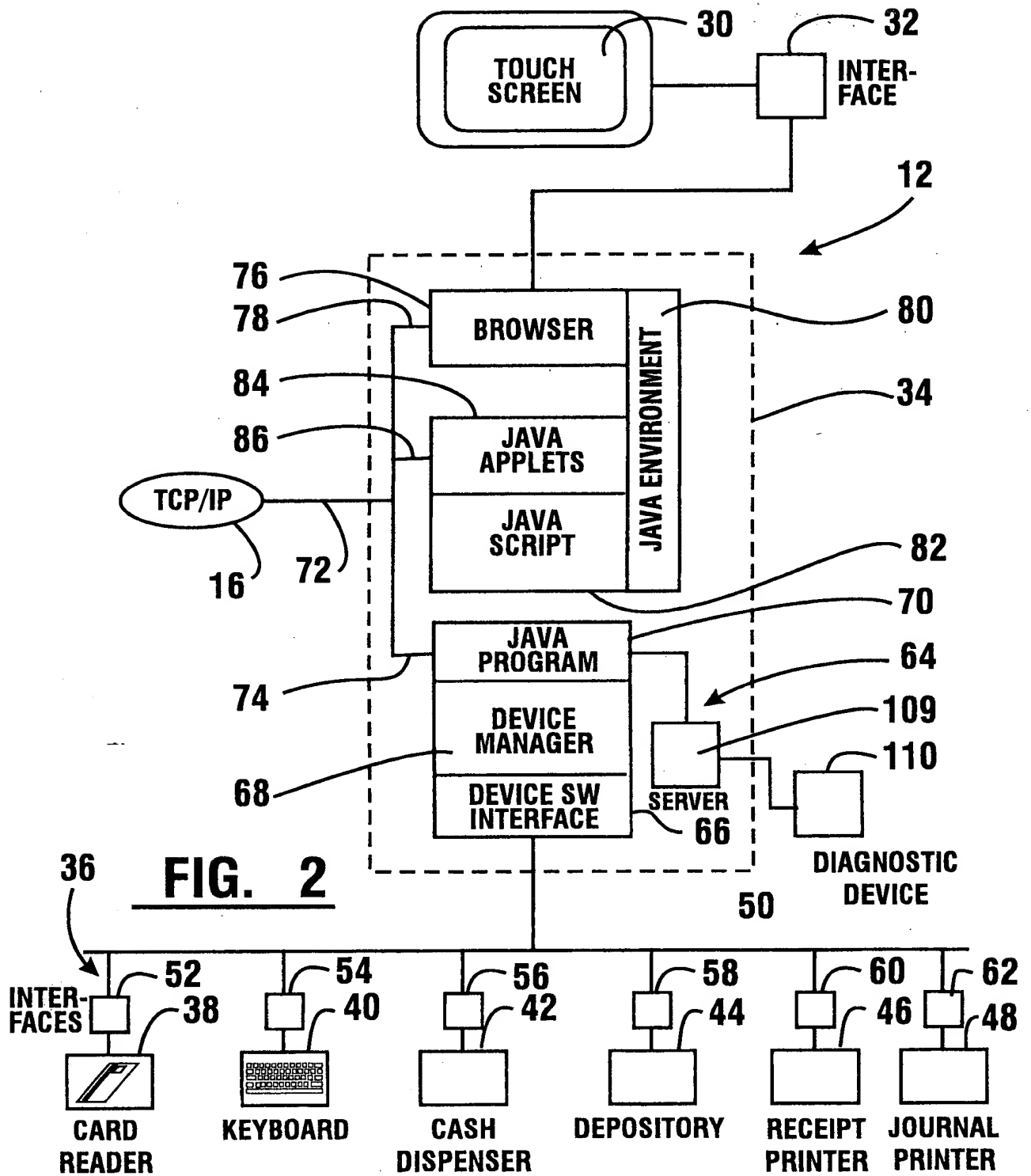




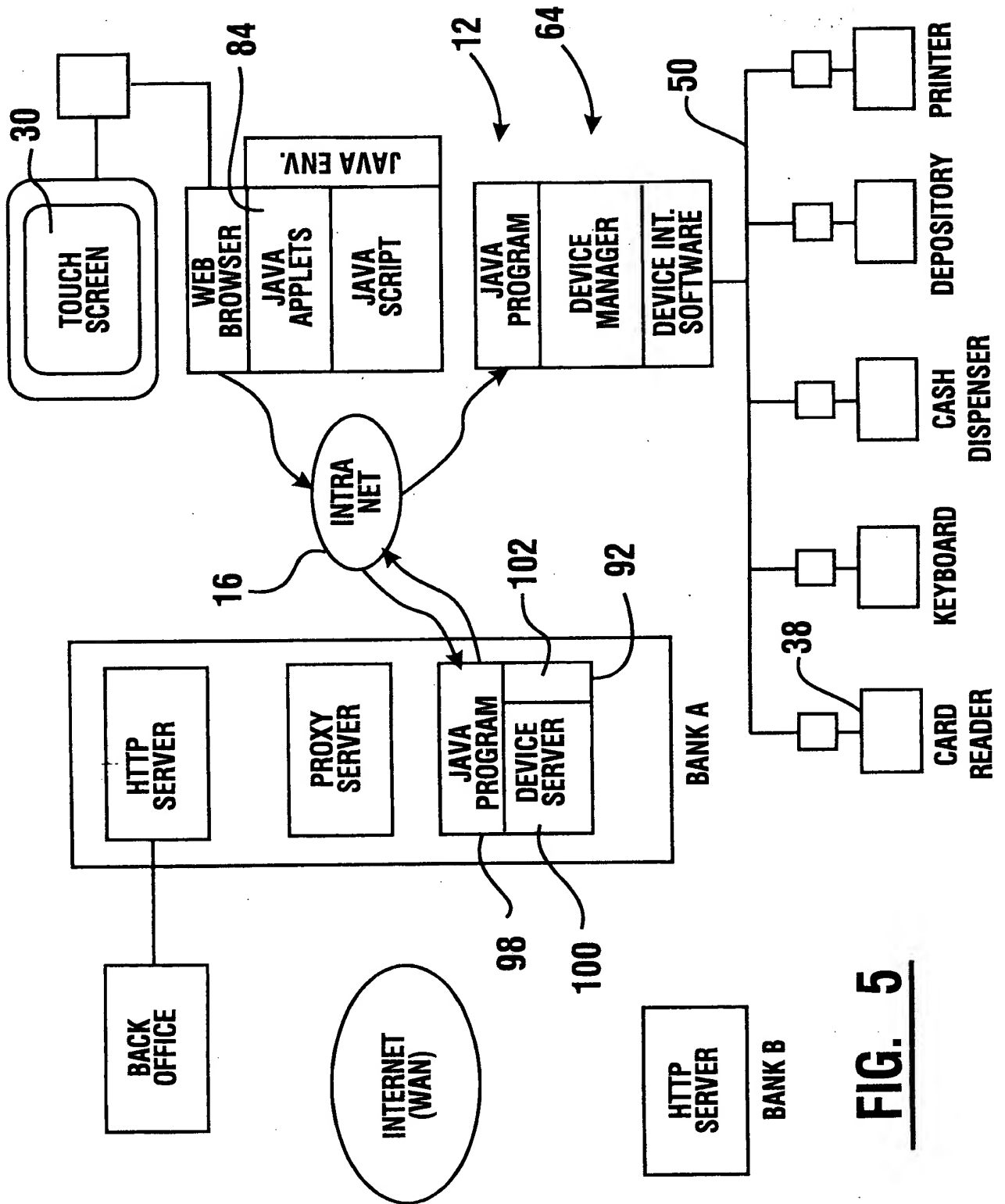
**FIG. 5**

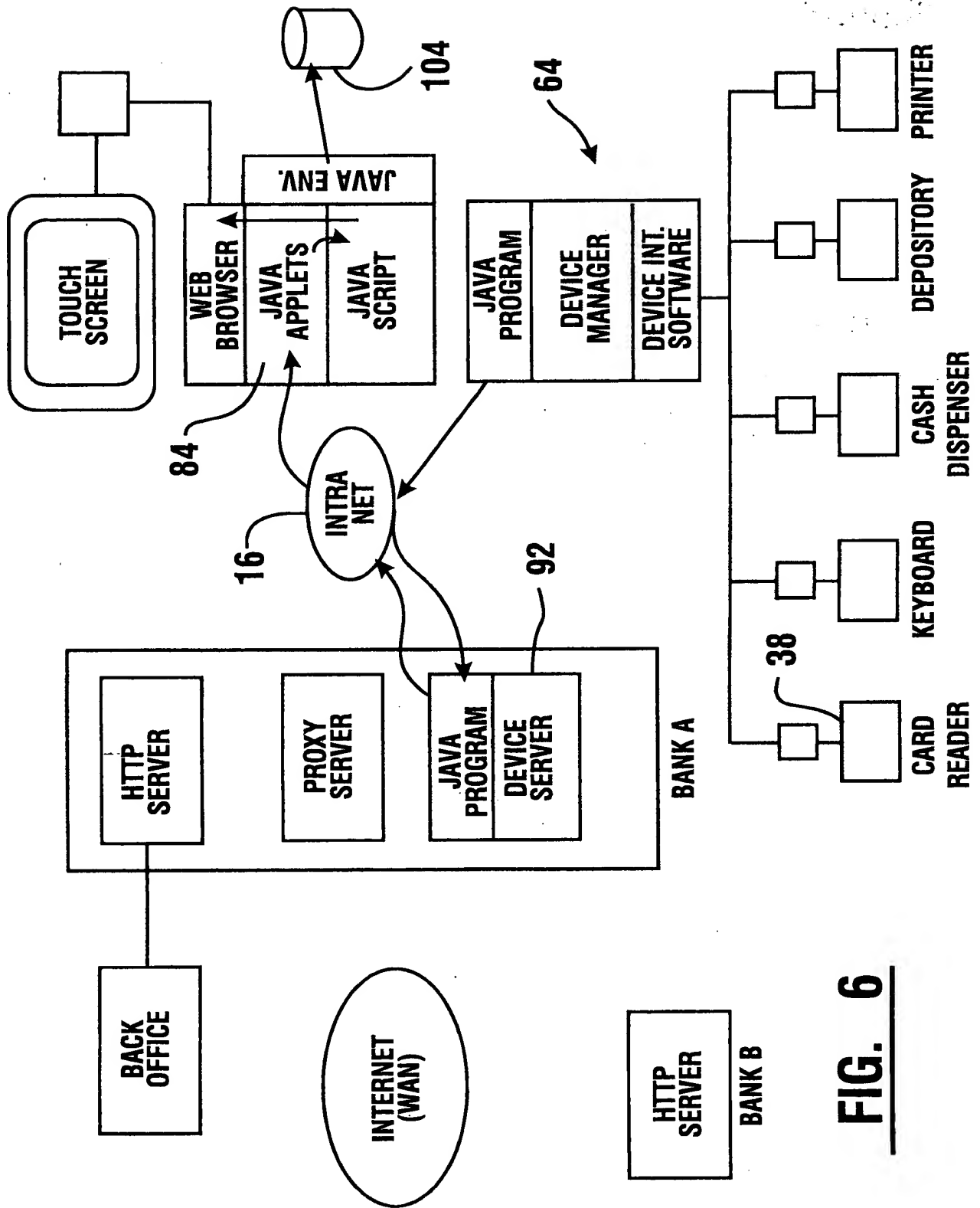
**FIG. 6**







**FIG. 5**

**FIG. 6**